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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,813	06/25/2001	Kiyohiko Uchida	00816-MN	7474

466 7590 09/15/2003

YOUNG & THOMPSON  
745 SOUTH 23RD STREET 2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER

FONTAINE, MONICA A

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 09/15/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/807,813

**Applicant(s)**

UCHIDA ET AL.

**Examiner**

Monica A Fontaine

**Art Unit**

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other:

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## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (U.S. Patent 3,971,115), in view of Jensen et al. (U.S. Patent 4,636,345).

Regarding Claim 1, Schneider et al., hereafter "Schneider," show that it is known to carry out a method for producing a roller (Abstract; It is noted that the limitation of a "paper feed" roller is placed only in the preamble of the claim, and has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) comprising a rotary shaft and a cylindrical roller portion around an outer periphery of the rotary shaft (Column 2, lines 50-52), characterized in that the roller

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portion is formed by extruding a composition and curing and hardening the extrudate (Column 3, lines 2-32). Schneider does not explicitly show the extrusion of a hydraulic composition. Jensen et al., hereafter "Jensen," show that it is known to extrude a hydraulic composition (Column 4, lines 39-49; Column 5, lines 1-6). Jensen and Schneider are combinable because they are concerned with a similar technical field, namely, that of making an article that is substantially smooth and has a uniform outer surface without material defects. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Jensen's material in Schneider's roller-making process in order to obtain a surface finish that has the physical and chemical characteristics of a molded hydraulic composition.

Regarding Claim 2, Schneider shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the composition is concentrically extruded around the rotary shaft, and cured and hardened to integrate the rotary shaft and the roller portion (Column 3, lines 2-32; It is noted that the extruded composition 2' and the rotary shaft 1' are concentric, as demonstrated by the centerline shown in Figure 2.), and cured and hardened to integrate the rotary shaft and the roller portion (Column 3, lines 17-32). As in Claim 1, Schneider does not explicitly show the extrusion of a hydraulic composition. Jensen et al., hereafter "Jensen," show that it is known to extrude a hydraulic composition (Column 4, lines 39-49; Column 5, lines 1-6). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Jensen's material in Schneider's roller-making process in order to obtain a surface finish that has the physical and chemical characteristics of a molded hydraulic composition.

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Regarding Claim 3, Schneider shows the process as claimed as discussed in the rejection of Claim 1 above, but does not show a specific hydraulic composition. Jensen shows that it is known to extrude a hydraulic composition which comprises 100 wt. parts of a mixed powder (Column 4, lines 39-47), 2 to 9 wt. parts of a workability improver (Column 4, lines 27-38, 66-68), and 0.5 to 5 wt. parts of a thickening agent (Column 4, lines 50-53), said mixed powder comprising 40 to 80 wt. parts of a hydraulic powder (Column 4, lines 39-45), 10 to 50 wt. parts of a non-hydraulic powder having the average particle diameter smaller than that of the hydraulic powder by an order of one digit or more (Column 3, line 67 - Column 4, lines 1-4, 47-49), and 10 to 30 wt. parts of an extrusion improver (Column 4, lines 54-57). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Jensen's specific hydraulic composition in Schneider's roller-making process in order to obtain a surface that has the physical and chemical characteristics of that composition.

Regarding Claim 4, Schneider shows the process as claimed as discussed in the rejection of Claim 3 above, but does not show a specific extrusion improver. Jensen shows that it is known to extrude a hydraulic composition which includes an extrusion improver that is an inorganic scaly material (Column 3, lines 36-61). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Jensen's extrusion improver during Schneider's roller-making process in order to improve the quality of the extruded product.

Regarding Claims 5 and 7, Schneider shows the process as claimed as discussed in the rejection of Claims 3 and 4 above, respectively, but does not show a specific workability improver. Jensen shows that it is known to extrude a hydraulic composition wherein the workability improver is a vinyl acetate resin (Column 4, lines 26-31; It is noted that polyvinyl

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alcohol is a vinyl acetate (see attached data sheet).). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Jensen's workability improver during Schneider's roller-making process in order to improve the quality of the extruded product.

Regarding Claim 6, Schneider shows the process as claimed as discussed in the rejection of Claim 1, including the roller formed by his roller-making process (Column 1, line 51 - Column 2, line 3), meeting applicant's claim.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to extruding hydraulic compositions over existing articles:

U.S. Patent 3,880,664 to Schulze

U.S. Patent 3,929,957 to Holden et al.

U.S. Patent 4,111,711 to Kiehl et al.

U.S. Patent 4,349,398 to Kearns et al.

U.S. Patent 4,398,960 to Murray

U.S. Patent 4,863,541 to Katz et al.

U.S. Patent 5,026,451 to Trzeciecki et al.

U.S. Patent 5,143,674 to Busck

U.S. Patent 5,151,147 to Foster et al.

U.S. Patent 5,545,297 to Andersen et al.

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U.S. Patent 5,876,288 to Jaskowiak

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A Fontaine whose telephone number is 703-305-7239.

The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 703-305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Maf  
September 5, 2003



**MICHAEL COLAIANNI**  
**PRIMARY EXAMINER**